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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,670	08/06/2002	Chia-Lin Chang	ACSP0004USA	5326

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EXAMINER
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EISEN, ALEXANDER

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/064,670

Applicant(s)

CHANG ET AL.

Examiner

Alexander Eisen

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the rejection of the last Office action is persuasive and, therefore, the rejection of that action is withdrawn. Particularly, the Applicant has pointed out that references of record do not explicitly teach "a heavyweight section". A rejection, based on the new grounds, including prior art teaching that feature, follows.

### ***Claim Objections***

2. Claim 12 is objected to because of the following informalities: claim recites "said front side" which is apparently should read --said front section--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9 and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nagai et al., ("Nagai"), JP 2001-056735.

With respect to claims 9 and 13 Nagai discloses a touch pen 60 (FIG. 3; [0013]) for inputting to a touch panel 20 and having a handhold section 61a comprising a front section 62 comprising a contact body; a main section 63; the front section coupled to one end of the main section; a rear cover 61c coupled to a second end of the main section through a battery 70 and circuit 69; and, a heavy-weight section L1 mounted onto said main section at a location

Art Unit: 2674

intermediate said front section and said main section to thereby concentrate the weight of the touch pen at the handhold section of said touch pen.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaoka in view of Yoshimura (both references are of record), and further in view of Nagai.

With respect to claims 1, 9 and 13 Nagaoka discloses a pen for inputting to a touch panel comprising a contact body (tip 12); an intra-body (receiving member 11) comprising a front section; a front tube (front barrel 10) comprising a narrow opening formed at one end for clipping the contact body 12 and a hole on the opposite side of the tube for packaging the intra-body; a rear pillar tube 1 for packaging the rear section of the intra-body comprising a pillar (bushing 6); a rear pen sheath 7 for packaging the pillar.

Nagaoka does not disclose a heavyweight section near the front section and a rubber pen sheath for packaging the heavyweight section and for increased comfort.

Nagai teaches a writing device for coordinate reader (a touch pen 60) having a heavyweight section (coil L1) arranged near the grip part so that the center of gravity gets closer to the grip section in order to improve the overall pen balance.

Art Unit: 2674

With respect to claims 1, 10 and 14 Yoshimura teaches a touch input pen having a grip portion 4 with a rubber ring 18 put thereon for reliable grip and comfort (FIGS. 1-4; col. 3, lines 17-67).

It would have been obvious to one of ordinary skill in the art at the time when the invention was made to use the rubber ring taught by Yoshimura in the pen of Nagaoka, because it would improve overall grasp of the pen by a user and prevent slippage of the head portion due to increased frictional force (col. 3, lines 60-67). It would be also obvious for one of ordinary skill at the time of the invention to improve the pen of Nagaoka with heavyweight part of Nagai in order to improve the weight balance of the pen and to provide additional comfort in using the pen (see abstract; FIG. 3; paragraph [0013]).

As to claim 2, the contact body 12 in Nagaoka is made of plastic (col. 3, lines 53-54).

As to claim 3, some inner parts of the pen are made from a metal (col. 2, lines 12-14) and it would be obvious to one of ordinary skill in the art at the time when the invention was made that any other parts can be also made of plastic or metal, which would simply constitute a matter of user's choice depending on design requirements.

As to claims 4, 11 and 15, it would be obvious to one of ordinary skill in the art that the heavyweight section L1 needs to be heavier and can be made of any weight comparably to the front section and rear section, 1.5 to 3.5 times of their respective gross weights including, and it would not be a burden to those of ordinary skilled in the art to do so without unduly experimentation.

As to claim 5, it would be obvious to make various parts of the pen from the plastic for the same reasoning as applied to claim 3.

Art Unit: 2674

As to claim 6, Nagaoka teaches a decorative design formed on the surface of the pen (see FIG. 3) for improving the grip of the pen by the user, and it would be obvious to have such a design on the rubber-gripping portion of the pen of Yoshimura.

As to claim 7, it would have been obvious to one of ordinary skill in the art at the time of the invention that the rear sheath can be made of plastic of any color, and can be of any various types.

As to claim 8, Nagaoka teaches that the rear pen sheath 7 has a protruding clipper 9.

As per claim 12, as can be seen from figures in Nagaoka, the front section of intra-body 11 is located under grip barrel 10 and therefore defines a handhold section.

#### ***Response to Arguments***

7. Applicant's arguments have been fully considered but are moot in view of the new ground(s) of rejection presented by this Office action.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (703) 306-2988. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2674

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alexander Eisen', with a stylized flourish at the end.

Alexander Eisen  
Primary Examiner  
Art Unit 2674

18 January 2005